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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/863,707 | 05/23/2001 | Shyam K Subramanyan | 1608143-0003 | 1487 |

7470 7590 10/15/2004

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

HARRIS, CHANDA L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------------------------------------------------|--|
| Office Action Summary | Application No. 09/863,707 | Applicant(s) an SUBRAMANYAN ET AL. | |
| | Examiner Chanda L. Harris | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/01, 1/18/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The oath/declaration is not signed **and** dated by all inventors.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15-29, and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields et al. (US 6,347,943).

1. [Claims 1,16-17, 32]: Regarding Claims 1,16-17, and 32, Fields discloses incorporating subject matter to a network-based server, including a storage medium and enabling software. See Col.3: 26-29. Fields discloses receiving input from a first actor (i.e., a first user) to establish a learning path (i.e., individualized course of instruction)

comprising one or more network-based pages comprising media and receiving input from a second actor (i.e., a second user) to establish a learning path comprising one or more networked-based pages comprising media. See Abstract and Col.6: 22-48.

Fields discloses creating one or more learning paths based upon said subject matter.

See Col.4: 32-46 and Col.6: 22-48. Fields discloses establishing within the server network-based pages comprising media, said pages accessible to network users collaboratively. See Col.8: 4-19. Fields discloses a network over which an opportunity to access said server is provided to a plurality of network users and a connection between the server and the network which permits a plurality of network users to access said server (i.e., Intranet/Internet). See Col.3: 26-29.

2. [Claims 2-3,18-19]: Regarding Claims 2-3 and 18-19, Fields discloses wherein said enabling software includes a templating tool and the step of creating templates for collecting and incorporating said subject matter into said network-based server. See Col.5: 46-53.

3. [Claims 4-5, 20-21]: Regarding Claims 4-5 and 20-21, Fields' invention is capable of performing wherein said templates stored within and accessible from said server and wherein said templates are received electronically by users for uploading subject matter to said server. See FIG.3 and Col.3: 26-29.

4. [Claims 6, 22]: Regarding Claims 6 and 22, Fields discloses wherein said enabling software includes an authoring tool. See Col.5: 24-26.

5. [Claims 7, 23]: Regarding Claims 7 and 23, Fields discloses creating learning objects based upon said subject matter. See Col.6: 53-57.

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6. [Claims 8, 24]: Regarding Claims 8 and 24, Fields discloses wherein learning objects are automatically created (e.g., links) by said enabling software based upon said subject matter. See Col.6: 1-7.

7. [Claims 9, 25]: Regarding Claims 9 and 25, Fields discloses wherein learning objects are automatically created (i.e., editable types) by said enabling software based upon subject matter incorporated in said templates (i.e., question type). See Col.5: 46-53.

8. [Claims 10, 26]: Regarding Claims 10 and 26, Fields discloses wherein said enabling software includes a storyboarding tool (i.e., authoring mechanism). See Col.5: 24-26.

9. [Claims 11, 27]: Regarding Claims 11 and 27, Fields discloses the step of designing storyboards based upon said subject matter. See Col.6: 53-57.

10. [Claims 12, 28]: Regarding Claims 12 and 28, Fields discloses wherein storyboarding tasks are automatically assigned by said enabling software. See Col.5: 34-45.

11. [Claims 13, 29]: Regarding Claims 13 and 29, Fields discloses wherein said enabling software includes a messaging tool (i.e., communication system). See Col.7: 65-Col.8: 3.

12. [Claims 15, 31]: Regarding Claims 15 and 31, Fields discloses wherein said enabling software includes a synchronous communication tool (e.g., line-by-line chat).. See Col.8: 4-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Cook et al. (US 5,727,950).

[Claims 14,30]: Regarding Claims 14 and 30, Fields does not disclose expressly wherein said enabling software includes a version control tool (i.e., version control methods). However, Cook teaches in Col.21: 1-6. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate a version control tool into the method and system of Fields, in light of the teaching of Cook, in order to ensure that only up-to-date software and materials data are used.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Griswold et al. (US 5,890,911)
 - automatic creation of learning objects
- Hopp et al. (US 6,685,482)
 - automatic creation of learning objects
- Koskinen (US 6,527,556)


- learning path, storyboard
- Lubin et al. (US 5,395,243)
 - learning paths
- Koskinen (US 6,062,862)
 - learning path, story board

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Chanda L. Harris
Examiner
Art Unit 3714